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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GREGORY L. SLAUGHTER, THOMAS E. SAULPAUGH,  
BERNARD A. TRAVERSAT, and MOHAMED M. ABDELAZIZ

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Appeal 2008-005948  
Application 09/660,563  
Technology Center 2400

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Decided: September 10, 2009

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Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and  
JAMES R. HUGHES, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 30. We have jurisdiction under 35 U.S.C. § 6(b).

We vacate the rejections encompassing all claims on appeal and, within the provisions of 37 C.F.R. § 41.50(b), institute a new ground of rejection of all claims on appeal, claims 1 through 30, under 35 U.S.C. § 101.

### *Invention*

A system, method, and medium for advertising, addressing, and/or accessing services in a distributed computing environment are provided. A service advertisement includes substantially all the information needed by a client to access a particular service. A service may publish the service advertisement in a space which stores documents such as Extensible Markup Language (XML) documents. The advertisement may include a Uniform Resource Identifier (URI) and a XML schema for the service. The schema specifies XML messages which are usable to invoke functions of the service. A client may access the space and read the advertisement. (Spec. 175, Abstract, ll. 3-10; Fig. 6).

### *Illustrative Claim*

1. A method comprising:  
a client reading an advertisement from a space, wherein the space comprises a network-addressable storage location, wherein the advertisement comprises a Uniform Resource Identifier (URI) and a schema, wherein the URI specifies a network address at which a service may be accessed, and wherein the schema specifies one or more messages usable to invoke one or more functions of the service;  
and

the client sending a first message to the service at the URI,  
wherein the first message is specified in the schema.

*Prior Art and Examiner's Rejections*

The Examiner relies on the following references as evidence of  
anticipation and unpatentability:

Roberts	6,560,633 B1	May, 6, 2003 (filed Jun. 10, 1999)
Beck	6,604,140 B1	Aug. 5, 2003 (filed Sep. 23, 1999)

Claims 1 through 5, 7 through 15, 17 through 25, and 27 through 30  
stand rejected under 35 U.S.C. § 102(e) as being anticipated by Beck.  
Claims 6, 16, and 26 stand rejected under 35 U.S.C. § 103. As evidence of  
obviousness, the Examiner relies upon Beck in view of Roberts.

FINDINGS OF FACT

1. We reproduce the disclosed subject matter at page 31, lines 19  
through 22 of the Specification:

As shown in Figure 6, two kinds of software programs may run  
in the distributed computing model: services 112 and clients 110.  
Services 112 may advertise their capabilities to clients wishing to use  
the service. The services 112 may advertise their capabilities in  
spaces 114.

2. We also reproduce the disclosed subject matter at page 167, line  
32 through page 168, line 5 of the Specification:

Various embodiments may further include receiving or storing  
instructions and/or data implemented in accordance with the foregoing  
description upon a carrier medium. Suitable carrier media may

include storage media or memory media such as magnetic or optical media, e.g., disk or CD-ROM, as well as transmission media or signals such as electrical, electromagnetic, or digital signals, conveyed via a communication medium such as network and/or a wireless link.

### ANALYSIS

At the outset, we vacate the Examiner's rejection of all claims on appeal under 35 U.S.C. § 103. We do so because we conclude that the claims are "barred at the threshold by § 101." *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (citing *Diamond v. Diehr*, 450 U.S. 175, 188 (1981)). Therefore, we reject all claims on appeal, claims 1 through 30, as being directed to non-statutory subject matter.

The United States Supreme Court has held that a claim is not a patent-eligible "process" if it claims "laws of nature, natural phenomena, [or] abstract ideas." *Diamond v. Diehr*, 450 U.S. at 185 (citing *Parker v. Flook*, 437 U.S. 584, 589 (1978) and *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). The subject matter of claims permitted within 35 U.S.C. § 101 must be a machine, a manufacture, a process, or a composition of matter. Moreover, our reviewing court has stated that "[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If the claim covers material not found in any of the four statutory categories, that claims falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful." *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007), *reh'g en banc denied*, 515 F.3d 1361 (Fed. Cir. 2008), *cert. denied*, 127 S. Ct. 70 (2008). *Accord In re Ferguson*, 558 F.3d 1359 (Fed. Cir. 2009). This latter case held that claims directed to a

“paradigm” are non-statutory under 35 U.S.C. § 101 as representing an abstract idea.

All claims on appeal, in particular independent claims 1, 11, and 21, variously recite a space, messages, advertisements, and schemas, each of which directly relates to abstract ideas or abstract intellectual concepts. These terms also relate or may be fairly characterized as mere data constructs not unlike and clearly akin to the “paradigm” of *In re Ferguson*. Some of these terms are merely virtual data constructs of real world elements or things, none of which are positively recited. As disclosed, “space” is considered an object depository, which in itself is another variation of an abstract data construct.

Each independent claim on appeal in some manner recites clients and services. From Finding of Fact 1, it is apparent that these are software programs in accordance with a distributed computing “model” depicted in Figure 6. Therefore, these entities are not recited as physical structures or locations.

On its face, independent method claim 1 purports to be statutory subject matter as a “process” within 35 U.S.C. § 101. On the other hand, the actual recitations in the body of the claim of such method directly relate to non-statutory subject matter as noted earlier in this Opinion. The Supreme Court’s “machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101.” *In re Bilski*, 545 F.3d 943, 956 (Fed. Cir. 2008) (en banc), *cert. granted*, 129 S. Ct. 2735 (U.S. Jun. 1, 2009) (No. 08-964). “A claim process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *Id.* at 954. The

present version of method independent claim 1 does not meet these requirements.

Turning to independent “system” claim 11, again the body of this claim recites subject matter essentially recited in the body of method independent claim 1, where the client is said to be merely “operable to” perform two functionalities. Again referencing our previous analysis and Finding of Fact 2, the claim’s system is clearly directed to a software system alone with no hardware system specified.

As to independent claim 21, its preamble recites a “computer-readable storage medium comprising program instructions.” Based upon Appellants’ statements in the Specification, reproduced in Finding of Fact 2, Appellants’ medium is directed to encompass transmission media or signals in various forms transmitted over a communication medium including a network and/or a wireless link. As such, the claimed medium is not directed to a tangible medium but appears to be directed to signal embodiments proscribed by *In re Nuijten*, 500 F.3d 1346, 1357 referenced earlier in this Opinion. Moreover, the program instructions of the preamble are recited in terms of the software client mentioned earlier in this Opinion. Since the instructions are merely recited in the preamble to be computer executable, there is no positively stated computer; it is only passively recited. There is also no recitation in the present tense of any instruction execution in claim 21.

## CONCLUSION AND DECISION

We have vacated the outstanding rejections under 35 U.S.C. §§ 102 and 103 encompassing all claims on appeal, claims 1 through 30. Within the

provisions of 37 C.F.R. § 41.50(b), we have rejected these claims as being directed to non-statutory subject matter within 35 U.S.C. § 101.

In addition to vacating the Examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that "[a] new ground of rejection . . . shall not be considered final for judicial review."

Section 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

VACATED  
37 C.F.R. § 41.50(b)

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